

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed April 27, 2005. At the time of the Office Action, Claims 1-55 were pending in the Application. Applicant amends Claims 1, 11, 21, 31, 41, 46, and 51 and cancels Claims 3, 13, 23, 33, 43, 48, and 53 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-3, 5-6, 11-13, 15-16, 21-23, 26, 31-33, 36, 39-43, 46-48, and 51-53 under 35 U.S.C. §103(a) as being anticipated by U.S. Patent No. 6,711,141 issued to Rinne (hereinafter "*Rinne*") in view of U.S. Patent No. 6,587,457 issued to Mikkonen (hereinafter "*Mikkonen*"). The Examiner rejects Claims 4, 14, 24-25, 34-35, 44-45, 49-50, and 54-55 under 35 U.S.C. §103(a) as being unpatentable over *Rinne* in view of *Mikkonen*, as applied to Claims 1, 11, 21, 31, 41, 46, and 51, and further in view of International Publication No. WO 98/44639 issued to Mustajarvi (hereinafter "*Mustajarvi*"). The Examiner rejects Claims 7, 17, 27, and 37 under 35 U.S.C. §103(a) as being unpatentable over *Rinne* in view of *Mikkonen*, as applied to Claims 1, 11, 21, and 31 and further in view of U.S. Patent No. 6,680,943 issued to Gibson (hereinafter "*Gibson*"). The Examiner rejects Claims 8-9, 18-19, 28-29, and 38 under 35 U.S.C. §103(a) as being unpatentable over *Rinne* in view of *Mikkonen*, as applied to Claims 6, 16, 26, and 36 and further in view of *Mustajarvi*. The Examiner rejects Claims 10, 20, and 30 under 35 U.S.C. §103(a) as being unpatentable over *Rinne* and *Mikkonen*, as applied to Claims 6, 16, 26, and 36 and further in view of U.S. Patent No. 6,408,001 issued to Chuah et al. (hereinafter "*Chuah*"). These rejections are respectfully traversed for the following reasons.

Once again, Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

It is respectfully submitted that Independent Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation. For example, Independent Claim 1 recites: correlating the label information to the data session, wherein the mobile unit is operable to: allocate a session specific label in response to session activity associated with an end user of the mobile unit; communicate a new label stack to the serving node such that the serving node can perform routing at a layer two level; store one or more flow labels for a plurality of applications of the mobile unit; classify one or more flows using one or more flow characteristics; and provision one or more of the flow labels for one or more of the flows based on one or more of the flow characteristics.

In contrast to the teachings of Independent Claim 1, nothing in *Rinne* or in *Mikkonen* offers any architecture that offers an ability to communicate a new label stack to the serving node such that the serving node can perform routing at a layer two level, or an ability to classify and provision flow labels based on flow characteristics. Turning to the first portion of this subject matter, there is no “new label stack” disclosed in any of the portions of *Rinne* that are cited by the Examiner.

In particular, in the Office Action, the Examiner cites an erroneous segment of *Rinne* that merely provides: “Another local 16 bit code point space is XXXX11, so it is in principle possible to separate 16 different QoS profiles by a code point. Code points and the corresponding profiles are also maintained in the packet classifier PAC, so the PAC is, according to the IP source address and said DSCP field in the IP header, able to sort the packets to be sent in uplink direction in an essentially unique manner to be sent conforming to the desired QoS profile.” (See *Rinne*: Column 6, lines 44-52.) Obviously, this is not akin to *communicating a new label stack to the serving node* such that the serving node can perform routing at a layer two level, as there is no “new label stack” even present: much less one that would enable routing at a layer two level.

¹ See M.P.E.P. §2142-43.

The Examiner concedes that this subject matter is missing from *Rinne* (See Office Action: page 4), but attempts to cite what is “known in the art” for this limitation. Note that the lack of communication of a new label stack is not trivial, as it makes up a significant portion of Independent Claim 1. Moreover, where a new label stack is missing in such an arrangement, then the result is that the architecture cannot offer the layer-two routing feature of the present invention. Note that processing requirements of layer-two routing are going to be disparate from other types of routing and switching. Hence, because the absence of this layer-two routing feature is conceded by the Examiner and because layer-two routing is fundamental to the pending subject matter, Independent Claim 1 is clearly allowable over *Rinne*. Thus, for at least this single reason, Independent Claim 1 is patentably distinct from *Rinne* and *Mikkonen*.

Turning to the second identified portion of Independent Claim 1, nothing in *Rinne* or *Mikkonen* offers an ability store one or more flow labels for a plurality of applications of the mobile unit; classify one or more flows using one or more flow characteristics; and provision one or more of the flow labels for one or more of the flows based on one or more of the flow characteristics. For this teaching, the Examiner only offers a simple table in *Rinne* that fails to disclose such limitations. (See *Rinne*: Columns 5-6.) The rudimentary table merely provides generic QoS classifications, but fails to illustrate a mobile station being capable of classifying and provisioning flow labels, as outlined by Independent Claim 1. For at least this additional reason, Independent Claim 1 is patentable over the proffered *Rinne-Mikkonen* combination.

In addition, Applicant also wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, usage of the *Rinne* reference or of the proposed *Rinne-Mikkonen*, *Rinne-Gibson*, *Rinne-Mustajarvi*, or *Rinne-Ton* combinations is still improper because the Examiner has not shown the required suggestion or motivation in *Rinne*, *Mikkonen*, *Gibson*, *Mustajarvi* or in *Ton*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination.² Thus, the sheer fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.³

Nothing in *Rinne*, *Mikkonen*, *Gibson*, *Mustajarvi*, or in *Ton* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.⁴ This is because the references fail to include the above-identified functionality and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.⁵ guidelines and governing Federal Circuit case law.⁶ The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.⁷ Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and

² M.P.E.P. §2143.01 (emphasis in original).

³ *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

⁴ If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

⁵ See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁶ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

⁷ See M.P.E.P. §2145.

unknown authority.”⁸ Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”⁹

In the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a *prima facie* case of obviousness.

Independent Claims 11, 21, 31, 41, 46, and 51 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

⁸ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).
⁹ See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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